

REMARKS

A. Background

Claims 1-21 were pending in the application at the time of the Office Action. Claims 1-6, 9-16, and 19-21 were rejected as being anticipated by cited art. Claims 7, 8, 17, and 18 were objected to as being dependent upon a rejected base claim. By this response Applicant has amended claims 10, 12, and 20. As such, claims 1-21 remain pending in the application.

B. Proposed Amendments

By this response, Applicant has amended claims 10, 12, and 20 to correct grammatical and other errors. Applicant submits that the amendments to the claims do not introduce new matter and entry thereof is respectfully requested.

C. Foreign Priority

The present invention claims priority to Swedish Application Serial No. 0100014-0. A certified copy of this application was submitted to the PTO by Express Mail on March 25, 2002, as shown on the USPTO PAIR system. Applicant notes that the present Office Action does not acknowledge the claim to foreign priority nor receipt of the certified copy of the Swedish application. Applicant thus respectfully requests that the Examiner acknowledge the claim for foreign priority and receipt of the certified copy.

D. Rejection on the Merits

1. Anticipation Rejection

Paragraph 2 of the Office Action rejects claims 1-6, 9-16, and 19-21 under 35 USC § 102(e) as being anticipated by U.S. Patent No. 6,799,039 to Wu et al. Applicant respectfully traverses this rejection.

To qualify as prior art under 35 USC § 102(e), the prior art must have a filing date that predates the date of invention of the application. Wu has a filing date of April 13, 2001, which predates the filing date of the current application (December 27, 2001). However, the current application claims priority to Swedish patent application 0100014-0 filed on January 3, 2001, which is earlier than the Wu filing date. Thus, the current application relates to an invention made before January 3, 2001. As a result, the Wu application, by itself, does not qualify as prior art to the current application.

Wu does provide a claim for priority back to a provisional application (60/197,554) having a filing date of April 17, 2000, which antedates the filing date of the Swedish application. However, a U.S. patent can **only** rely on the date of the provisional application, as a 35 U.S.C. 102(e) critical reference date, “**if** the provisional application(s) properly supports the subject matter relied upon to make the rejection.” MPEP § 2136.03(III), *emphasis in original*. In other words, in circumstances where the patent does not predate the application under examination, only those teachings which are taught by the provisional application can be used as support for an anticipation rejection. Thus, the only teachings of Wu that can be used as possible prior art to the current application are those teachings that are also disclosed in the ‘554 provisional application, as those are the only teachings that predate the filing of the Swedish application.¹

¹ It will be noted that Applicant does not admit that the ‘554 provisional application is in fact prior art to the claimed invention. To the contrary, Applicant reserves the right to swear behind the ‘554 provisional application at any appropriate time in the future.

Specific attention will now be directed to the limited disclosure of provisional application 60/197,554 (the '554 provisional application). Initially, it will be noted that the '554 provisional application is a very brief (3 page) document that discloses only a cursory outline of a wireless network inter-system handoff between two different air-interface systems.

As such, Applicant submits that the '554 provisional application does not teach or suggest the recited elements of the claims, and particularly independent claims 1 and 12. For example, among other things, the '554 provisional application clearly fails to teach or suggest:

- transmitting, from the server to the wireless communication station, a request for information relating to the radio transferring capabilities associated with the wireless communication station; or
- adapting, at the server, the information content to be transmitted from the server to the wireless communication station based upon a response from the wireless communication station to said request,

as recited in claim 1, or

- receiving, from an originator of information, a request for information relating to the radio transferring capabilities of the wireless communication station; or
- transmitting to said originator a response to said request, wherein information relating to the radio transferring capabilities associated with the wireless communication station is included in the response,

as recited in claim 12. Thus, because the '554 provisional application does not teach each and every element as set forth in the claims, the current rejections based on Wu are now moot. Accordingly, applicant respectfully requests that the anticipation rejection with regards to claims 1 and 12 be withdrawn.

Claims 2-6, 9-11, 13-16, and 19-21 each depend from one of claims 1 and 12 and thus incorporate the limitations thereof. As such, applicant submits that claims 2-6, 9-11, 13-16, and 19-21 are distinguished over the cited art for at least the same reasons as discussed above with regard to claims 1 and 12. Accordingly, applicant respectfully requests that the obviousness rejection with regards to claims 2-6, 9-11, 13-16, and 19-21 also be withdrawn.

2. Allowable Subject Matter

Paragraph 3 of the Office Action objects to claims 7, 8, 17, and 18 as being dependent upon a rejected base claims but states that these claims would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. Claims 7, 8, 17, and 18 each depend from one of claims 1 and 12. Since claims 1 and 12 are distinguishable over the cited art for at least the reasons as set forth above, applicant submits that dependent claims 7, 8, 17, and 18 are also in condition for allowance.

No other objections or rejections are set forth in the Office Action.

E. Conclusion

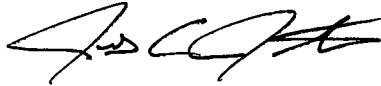
Applicant notes that this response does not discuss every reason why the claims of the present application are distinguished over the cited art. Most notably, applicant submits that many if not all of the dependent claims are independently distinguishable over the cited art. Applicant has merely submitted those arguments which it considers sufficient to clearly distinguish the claims over the cited art.

In view of the foregoing, applicant respectfully requests the Examiner's reconsideration and allowance of claims 1-21 as amended and presented herein.

In the event there remains any impediment to allowance of the claims which could be clarified in a telephonic interview, the Examiner is respectfully requested to initiate such an interview with the undersigned.

Dated this 20th day of June, 2006.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Jens C. Jenkins', with a stylized, cursive script.

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